

AMENDMENTS TO THE DRAWINGS:

The attached sheets of drawings are identical in content to the drawings filed on August 2, 2007 and April 17, 2008. Thus, the attached sheets of drawings include the changes/additions to Figure 7 of the drawings filed on August 2, 2007 and April 17, 2008, already explained, and explained again below for the Examiner's convenience. Otherwise, the attached sheets of drawings are formal versions of the *original* drawings, which are black and white line drawings and include minor changes/corrections to cross-hatching (of the original drawings) so that the cross-hatching does not look like shading, and include thicker line weights throughout to make the reference characters plain and legible as set forth in form PTO-948. These sheets, which include Figures 1-24, replace the original sheets including Figures 1-24.

Attachment: twelve (12) replacement sheets

REMARKS

In the November 20, 2009 Office Action, claims 11-17 stand rejected in view of prior art. Claims 11-18 and 22-31 also were as being indefinite for failing particularly point out and distinctly claim the subject matter that Applicant regards as the invention.

Status of Claims and Amendments

In response to the November 20, 2009 Office Action, Applicant has amended claims 1 and 14, and cancelled claim 13, as indicated above. Thus, claims 1-12 and 14-31 are now pending, with claims 1, 11, 19 and 22 being the only independent claims. Reexamination and reconsideration of the pending claims are respectfully requested in view of above amendments and the following comments.

Petition

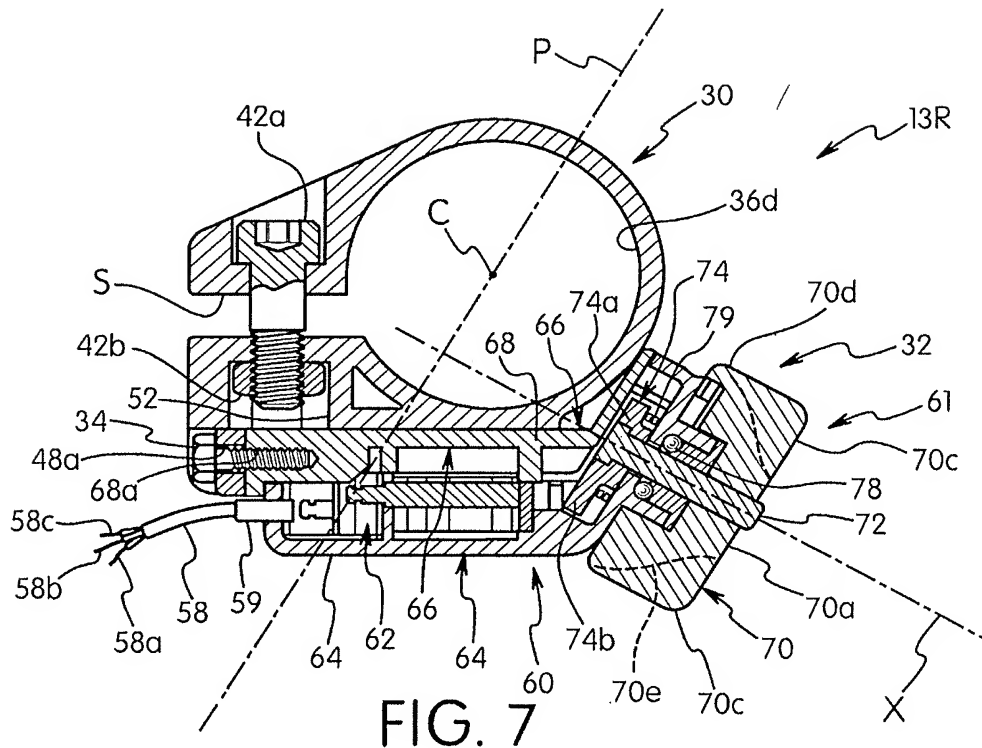
Applicants Petition filed January 15, 2008 of the objections to the August 2, 2007 Amendment for allegedly introducing new matter was ***granted*** on January 8, 2010.

Drawings

In paragraph 4 of the Office Action, the drawings filed August 2, 2007 were objected to for allegedly introducing new matter. However, the January 8, 2010 Decision on Petition indicates that the changes were not an introduction of new matter. Accordingly, Applicant respectfully requests withdrawal of this objection.

In paragraph 5(a), the drawings filed April 17, 2008 were also objected to for allegedly introducing new matter. However, the January 8, 2010 Decision on Petition indicates that the changes were not an introduction of new matter. Accordingly, Applicant respectfully requests withdrawal of this objection.

Applicant previously added the plane P that is perpendicular to the rotation axis X and passes through the center axis C to Figure 7 of the drawings. Also, the reference character "S" identifying the split was added to Figure 7 of the drawings. See the reproduction of Figure 7 below.



Adding this plane P that is perpendicular to the rotation axis X and passes through the center axis C to Figure 7 does not constitute an introduction of new matter. Rather, such a plane was inherently present in original Figure 7, but was merely not yet explicitly identified. In other words, a plane that is perpendicular to the rotation axis X and passes through the center axis C is inherently present in original Figure 7, and thus, is merely being clearly, explicitly identified as plane “P” by the August 2, 2007 Amendment. This change to Figure 7 was made in view of the previous changes to claim 22 (i.e., the plane and split are set forth in amended claim 22) and in view of an objection in the April 18, 2007 Office Action that “a mating mounting structure” set forth in the claims was not identified with a reference numeral. In other words, based on this prior objection, Applicant believed that the plane P and the split S should be clearly identified in the drawings to avoid a potential objection.

In paragraph 5(b), the drawings filed April 17, 2008 were objected to for allegedly being other than black and white, and for not satisfying the requirements of 37 C.F.R. §1.84(a)(2) for color drawings. This objection is not fully understood since the drawings

filed April 17, 2008 are believed to be black and white drawings. In fact, Applicant notes that the drawings filed April 17, 2008 were filed using the electronic filing system as black and white line drawings as indicated in the electronic filing receipt. Thus, this objection is not fully understood. In any case, Applicant has filed herewith twelve replacement sheets of drawings herewith, which are black and white line drawings with content identical to the drawings submitted on August 2, 2007 and April 17, 2008.

In paragraph 6 of the Office Action, the *original* drawings were objected as failing to comply with 37 CFR §1.84 and Applicant is advised to see an attached form PTO-948. In response, Applicant has again filed herewith twelve replacement sheets of drawings. These attached replacement drawings are believed to have lines, numbers and letters that are uniformly thick and well defined, clean, durable and black in accordance with 37 CFR §1.84(l). Also, the attached replacement sheets of drawings are believed to have lines of hatching that are sufficiently spaced apart in accordance with 37 CFR §1.84(h)(3) so that the cross-hatching does not look like shading. In other words, formal versions of the *original* informal drawings are again filed herewith in accordance with form PTO-948. Based on the above, Applicant respectfully requests that these objections be withdrawn.

Specification Objections

In paragraph 7 of the Office Action, the August 2, 2007 Amendment was objected to for allegedly introducing new matter in paragraph [0064]. This objection is respectfully traversed as set forth in the January 15, 2008 Petition under 37 CFR §1.181, ***Granted on January 8, 2010***. Specifically, Applicant Applicant amended paragraph [0064] to state “The pivot axis X preferably intersects the curved mounting surface 36d of the tubular clamping portion 36 such that the operating member 61 is disposed on an opposite side of a plane P from the split S. The plane P is perpendicular to the operating axis X and passes through the center axis C of the transverse portion T of the handlebar 14, as best seen in Figure 7.” Adding this language to the specification does not constitute an introduction of new matter. Specifically, such language is clearly supported by the original drawings (e.g., original Figures 3-6) and the original specification, which form parts of the original disclosure. See original Figure 7, which is reproduced below.

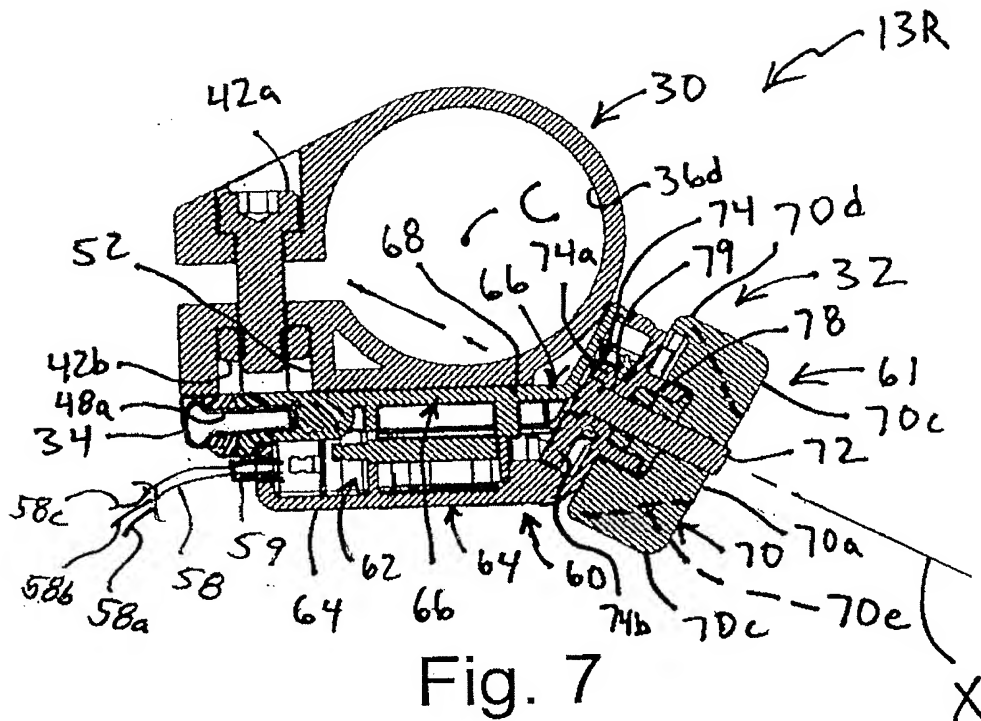


Fig. 7

It is clear from this Figure that *the operating member 61 is disposed on an opposite side of a plane (the plane being perpendicular to the operating axis X and passing through the center axis C of the transverse portion T of the handlebar 14) from the split of the portion 30.* In fact, it is clear from this Figure alone that the operating member and the split lie on opposite sides of many different planes, the plane P merely being one that is easily identifiable because of its arrangement relative to the operating axis X and the center axis C of the transverse portion T of the handlebar 14. Based on the above comments, Applicant respectfully requests that this objection be withdrawn.

Claim Rejections - 35 U.S.C. §112

In paragraph 9 and 10 of the Office Action, claims 11-18 and 22-31 were rejected under 35 U.S.C. §112, first paragraph as failing to comply with the written description requirement. Claims 11-18 were also rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter. In

response, Applicant has amended claim 11 to overcome the rejections of claims 11-18. Applicant traverses the rejection of claims 22-31.

Rejection of claims 22-31 under 35 U.S.C. §112, first paragraph

This rejection is respectfully traversed, especially in view of the January 15, 2008 Petition under 37 CFR §1.181, ***Granted on January 8, 2010***. In particular, it has now been determined that original Figure 7 above does disclose ***the operating member 61 is disposed on an opposite side of a plane (the plane being perpendicular to the operating axis X and passing through the center axis C of the transverse portion T of the handlebar 14) from the split of the portion 30***, and thus, this addition to the specification is not new matter. As argued in the April 17, 2008 Amendment, there is no *in haec verba* written description requirement. Rather, claim limitations may be supported in the specification through express, implicit or inherent disclosure. See MPEP 2163 (I)(B). The ***drawings form a part of the original disclosure***. In fact, in *Vas-Cath Inc. v. Mahhurkar* (1991), the court held: “under proper circumstances, drawings alone may provide a ‘written description’ of an invention as required by § 112.” See *Vas-Cath Inc. v. Mahhurkar*, 935 F.2d 1555, 19 USPQ2d 1111 (Fed Cir. 1991). In this case, the plane P was not originally identified. However, the plane P was inherently disclosed and the arrangements of the operating member and split relative to the inherent plane P were also inherently disclosed in Figure 7 of the original application as filed, as explained above. Thus, Applicant merely amended the specification and Figure 7 to identify the plane P with a reference character. Based on the above, it is clear that the original specification reasonably conveys to one of ordinary skill in the bicycle art that the inventor(s), at the time the parent application was filed, had possession of the claimed invention set forth in independent claim 22, especially if read ***with reference to the drawings***. In other words, based on the above, it is clear that the original specification ***expressly, implicitly or inherently*** provides adequate support (i.e., adequate written description) for previously presented claim 22. Therefore, Applicant respectfully submits that the arrangement of claims 22-31, “the operating member being disposed on an opposite side of a plane from the split, the plane passing through a center axis of the handlebar and being perpendicular to the operating axis” is supported in the application as filed. Accordingly, Applicant believes that claims 22-31 comply with 35 U.S.C. §112, first paragraph and

withdrawal of this rejection is respectfully requested. Thus, as indicated on page 13 of the Office Action, this rejection should now be withdrawn.

Rejection of claims 11-18 under 35 U.S.C. §112, first and second paragraphs

In response to these rejections, Applicant has amended independent claim 11 to require “a bicycle computer unit including a display screen, the bicycle computer unit being supported by attached to a computer support leg ~~the first tubular clamping member~~ of the first mounting portion, with the computer support leg being removeably secured within the split between the attachment ends.” As noted in the Office Action previously presented claim 11 was inconsistent with claim 13. Thus, Applicant has corrected the inconsistency and cancelled claim 13. See Figures 2, 3 and 5 and pages 8-10 of the instant application, where this arrangement is illustrated and/or discussed. Applicant believes claims 11, 12 and 14-18 now comply with 35 U.S.C. §112, first and second paragraphs. Accordingly, withdrawal of these rejections is respectfully requested.

Rejections - 35 U.S.C. § 103

In paragraph 11 of the Office Action, claims 11-17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over European Patent Publication No. 1 375 325 (Ichida et al.) in view of U.S. Patent No. 6,584,872 (Kojima). In response, Applicant has amended independent claim 1 to more clearly define the present invention over the prior art.

In particular, independent claim 11 now requires, *inter alia*, a first shift control device including a first mounting portion having a first tubular clamping member configured to be selectively clamped onto a bicycle handlebar and a first electrical shift control switch attached to the first tubular clamping member of the first mounting portion, the first tubular clamping member having a pair of attachment ends and a band section extending between the attachment ends to form a split between the attachment ends, the tubular clamping member being arranged and configured such that the attachment ends move toward each other to reduce an effective inner diameter of a curved mounting surface of the band section, with the split extending outwardly from the curved mounting surface so that the split is disposed radially outwardly of an outer surface of the bicycle handlebar relative to a longitudinal

center axis of the handlebar when the first tubular clamping member is clamped onto the bicycle handlebar; and

a bicycle computer unit including a display screen, the bicycle computer unit being attached to a computer support leg of the first mounting portion, with the computer support leg being removeably secured within the split between the attachment ends so that the computer support leg is disposed radially outwardly of the outer surface of the bicycle handlebar when the first tubular clamping member is clamped onto the bicycle handlebar and the computer support leg is secured within the split. Clearly this arrangement is *not* disclosed or suggested by the Ichida et al. publication and/or the Kojima patent, singularly or in combination.

The Office Action acknowledges that the computer 20 in the Ichida et al. publication is not supported within the split. However, the Office Action relies on the Kojima patent to allegedly disclose a computer 16/216 supported within a split 44. However, the so-called computer support leg 62a/162a of the Kojima patent is not received in the split 44. Moreover, the so-called computer support leg 62a/162a of the Kojima patent is not disposed radially outwardly of the split 44 relative to a longitudinal center axis of the handlebar. In fact, the so-called computer support leg 62a/162a is actually part of the handlebar in the Kojima patent. In any case, since neither the Ichida et al. publication nor the Kojima patent disclose or suggest a computer support leg removeably secured within a split as now claimed, a hypothetical device created by combining these references cannot disclose or suggest a computer support leg removeably secured within a split as now claimed. Accordingly, withdrawal of this rejection is respectfully requested.

Under U.S. patent law, the mere fact that the prior art can be modified does *not* make the modification obvious, unless an *apparent reason* exists based on evidence in the record or scientific reasoning for one of ordinary skill in the art to make the modification. See, KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1741 (2007). The KSR Court noted that obviousness cannot be proven merely by showing that the elements of a claimed device were known in the prior art; it must be shown that those of ordinary skill in the art would have had some "apparent reason to combine the known elements in the fashion claimed." Id. at 1741. The current record lacks any apparent reason, suggestion or expectation of success for combining the patents, and then further modifying a hypothetical device created by

Appl. No. 10/826,272
Amendment dated February 5, 2010
Reply to Office Action of November 20, 2009

combining these references to create Applicants' unique arrangement of independent claim 11. Accordingly, withdrawal of this rejection is respectfully requested.

Moreover, Applicant believes that the dependent claims 12-17 are also allowable over the prior art of record in that they depend from independent claim 11, and therefore are allowable for the reasons stated above. Also, dependent claims 12-17 are further allowable because they include additional limitations, which in combination with the limitations of independent claim 11, are not disclosed or suggested in the prior art of record. Accordingly, Applicant respectfully requests that this rejection of these dependent claims be withdrawn in view of the above comments and amendments.

* * *

In view of the foregoing amendment and comments, Applicant respectfully asserts that claims 1-12 and 14-31 are now in condition for allowance. Reexamination and reconsideration of the pending claims are respectfully requested.

Respectfully submitted,

/Patrick A. Hilsmier/
Patrick A. Hilsmier
Reg. No. 46,034

GLOBAL IP COUNSELORS, LLP
1233 Twentieth Street, NW, Suite 700
Washington, DC 20036
(202)-293-0444
Dated: February 5, 2010

S:\02-FEB10-YTY\SN-US045038 Amendment (Applicants singular).doc